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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,613	01/11/2002	Antonio T. Lato	INTL-0624-US (P11955)	9479

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EXAMINER

NGUYEN, THUAN T

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,613

Applicant(s)

LATTO ET AL.

Examiner

THUAN T. NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As for claim 17, this claim calls for the faceplate "*covering all of the upper surface of the base*" of an electronic device, which is an incorrect claim and also it is not *consistent* with claims 1 and 9; while claim 1 and claim 9 calls for a **substantially** transparent removable faceplate covering **substantially** all of the first surface. Furthermore, claim 17 is a misleading and incorrect claim because as shown in Figure 4 of the present application, Figure 4 clearly shows a *substantially transparent removable faceplate*, which is NOT covering "*all of the upper surface of the base*" of an electronic device as claimed.

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Claim Rejections - 35 USC 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (U.S. Patent No. 5,113,435) in view of Siemens (DE 20104924 U1).

Regarding claims 1-4, 12, 15, 17-19 (in addition to the Rejection 112-2nd above) and 21, Chen discloses an electronic device and its corresponding method such as a portable telephone with a base having a first surface, and with a transparent removable faceplate for covering substantially all of the first surface of the device (see Fig. 3, and col. 2/lines 14-42) and on that transparent faceplate, a design object is included for decoration (fig. 3, item 16). Chen does not disclose to include "replaceable ornamental insert positionable between the removable faceplate and the first surface of the base such that a portion of the ornamental insert is viewable through the substantially transparent section"; however, this technique is taught by Siemens (see Abstract, and Fig. 1, as with the English translation, a plastic cover 4 with exchangeable thin sheet 5 on which designs can be printed for personalizing decorations such as pictures of the user's family, for the portable phone 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Chen's transparent item for viewing

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through the numbers of the base of an electronic device with Siemen's technique of using exchangeable inserts for decoration between the base of the electronic device and a transparent plastic cover in order to obtain an easy technique in decorations for an electronic device, with the exchangeable inserts as ornamental inserts (as taught by Siemens), underneath a transparent removable faceplate as taught by Chen as desired.

As for claims 5-6 and 16, these claims are rejected for the same reasons given in the view for applying this technique for an electronic device, wherein the base is a base portion of a computer, as a generalized procedure for applying the decoration inserts underneath the transparent removable faceplate to a portable laptop computer, same as discussed in claims 1-4, 12-15, 17-19 and 21 above.

As for claims 7-8 and 14, these claims are rejected for the same reasons given in the view for applying this technique for an electronic device, wherein the base is a base portion of a digital game player, as a generalized procedure for applying the decoration inserts underneath the transparent removable faceplate to a digital game player, same as discussed in claims 1-4, 12-15, 17-19 and 21 above.

As for claims 9-11, 13 and 20, these claims are rejected for the same reasons given in the view for applying this technique for an electronic device, wherein the electronic device now is a digital audio player, as a generalized procedure for applying the decoration inserts underneath the transparent removable faceplate to a digital audio player, same as discussed in claims 1-4, 12-15, 17-19, and 21 above.

Response to Arguments

5. Applicant's arguments filed on 12/04/03 have been fully considered but they are not persuasive.

First, applicants argue that claim 17 calls for the faceplate "covering all of the upper surface of the base" of an electronic device, and the faceplate having a substantially transparent section, which is a misleading and incorrect claim (see the Examiner's rejection 112-2nd above).

Then, applicants strangely argue that **claim 1 is generally similar to claim 17, but** (emphasis added) calls for "*covering substantially all of the surface*" and bring up the difference between "all" and "substantially all." Now the applicants stated that "*an insignificant portion*" (which one?) is not covered as claimed in claim 1, and then applicants accuse Chen's reference and Siemens reference that "*a substantial portion of the surface is not covered*" by also bringing the case studies of **unrelated** patent cases (emphasis added). Which one and what can be defining as "significant" or "insignificant" portion, and the applicants simply based on their (own) assumption to conclude on the behalf of others that "a substantial portion of the surface is not covered" as for Chen and Taylor. In other words, in a similar reasoning (as of the applicants), one of ordinary skill in the art can easily realize that Chen and Taylor each has a substantially transparent faceplate to cover all of the surface of their device, because to Chen and Taylor's aspects, the "significant portion" of *their* device is already covered, leaving only the "insignificant portion" of *their* device uncovered (see the Office Action).

Therefore, the Examiner believes Chen and Taylor references teach a technique of using a transparent removable faceplate and a replaceable ornamental insert, as shown in the present application, as disclosed in the previous Office Action and discussed in this Final Office Action.

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Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II,

2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony Thuan Nguyen whose telephone number is (703) 308-5860. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is **(703) 306-0377**.



**TONY T. NGUYEN
PATENT EXAMINER**

Tony T. Nguyen, FSA
Art Unit 2685
February 19, 2004